REMARKS

This amendment is being filed in response to the Third Office Action, dated April 13, 2006. In that office action, claims 1-5, 7-14, and 16-19 were rejected under 35 USC §101 for being directed to non-statutory subject matter, and claims 1-19 were rejected under 35 USC §103 for being unpatentable over Marko, in view of Sonnenrein and Shirane. Claims 1, 2 and 8 are currently being amended, claims 10-14 and 16-18 are currently being cancelled, and claims 20-26 are currently being added.

Rejection Under 35 USC §101 –

Claims 1-5, 7-14, and 16-19 stand rejected under 35 USC §101 for being directed to non-statutory subject matter. More specifically, the Examiner stated that the subject matter of those claims is directed to an abstract idea rather than a practical application of the idea, and suggested the following modification, "e.g., in some instances, if it was conveyed to someone or something *or stored for retrieval...*" (Emphasis added.)

Although the Applicant respectfully traverses this rejection, amendments have been made to independent claim 1 such that it now calls for "*storing diagnostic data …* such that the stored diagnostic data is *made available for analysis*", pursuant to the Examiner's above-listed suggestion. It is the Applicant's opinion that the claimed subject matter produces a useful, concrete, and tangible result, as articulated in *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed.Circ., 1998), and therefore the Applicant requests that the Examiner reconsider this rejection.

Unlike claim 1, claim 19 recites a combination of elements in means-plus-function format. Embodiments of these means elements are disclosed in the specification and in the drawings. Accordingly, this claim is directed to an apparatus which is statutory subject matter under 35 USC §101.

Rejection Under 35 USC §103(a) –

Claims 1-19 stand rejected under 35 USC §103(a) as being unpatentable over Marko et al. (US Patent No. 6,745,151) in view of Sonnenrein et al. (US Patent Publication No. 2005/0154500) and Shirane et al. (US Patent No. 5,491,631). In view of the amendments to claims 1, 2 and 8 and the cancellation of claims 10-18, the Applicant respectfully traverses this rejection for at least the reason that Shirane fails to disclose or to even suggest, "*configuring* a primary diagnostic script for a *telematics equipped mobile vehicle* wherein the primary diagnostic script *recreates known problem sequences* when executed."

First, the Shirane patent, like the Marko and Sonnenrein references, fails to disclose a primary diagnostic script that *recreates known problem sequences*, as called for in claims 1 and 19. The Examiner points to the Shirane disclosure set forth in col. 10, line 50-col. 11, line 14[1] as evidence of such a disclosure; however, Shirane only discloses a program for detecting and analyzing a fault that has already occurred, and makes absolutely no mention of configuring a script that *purposely recreates a known problem sequence*. In the Applicant's opinion, the section of the Shirane patent that was identified by the Examiner simply describes a process for selecting and verifying a correct vehicle identification number (VIN), and then using that VIN for selecting a particular fault diagnostic program. As will be further elaborated below, that section has absolutely nothing to do with *recreating known problem sequences*.

The first part of this section (starting with col. 10, line 50) begins by discussing the scenario where two 'check digits' match. A check digit, according to Shirane, is simply the numeric that occupies the space "e" in the exemplary VIN shown in FIG. 5, and is inputted by an operator to make sure that the VIN has been entered without error.[2] Assuming that the VIN has been correctly entered, it is used as a key to select a particular fault diagnostic program from fault diagnostic program storage means 36. Once the fault diagnostic program is selected and performed, a fault diagnosis and analysis can be made

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[1] Office Action dated April 13, 2006; page 4
[2] US Patent No. 5,491,631; col. 9, lines 25-29

so that information such as the model, destination, production year, and production factory of the defective vehicle can be accurately gathered. There is no disclosure whatsoever that describes or even suggests configuring or otherwise developing a diagnostic script that *recreates known problem sequences*.

If the Examiner disagrees with the interpretation set forth in the preceding paragraph, then the Applicant respectfully asks that the Examiner specifically identify and explain those portions of the Shirane disclosure of col. 10, line 50 – col. 11, line 14 that disclose configuring a diagnostic script that recreates known problem sequences.

Second, Shirane does not teach *configuring* a primary diagnostic script, as recited in claims 1 and 19 and as taught in the present application. This distinction is similar to that already established with respect to the Marko patent, which the Examiner previously agreed "...fail[s] to teach configuring a primary diagnostic script for a telematics equipped mobile vehicle."[3] The fault diagnostic system described in Shirane, at best, simply selects a fault diagnostic program based on a vehicle identification number (VIN).

> In ROM 21, a table is stored for *selecting the optimal one out of the plurality of fault diagnostic programs on the basis of VIN* (vehicle identifier code) and ECU-ID. (Emphasis added.)[4]

> In step S9, the input check digit and a numeric as a reference data stored in ROM 21 are compared. If the comparison is successful, the process goes to step S10, where the VIN of the display example shown in FIG. 4E is read into the work area and *the fault diagnostic program corresponding to the VIN is selected.* (Emphasis added.)[5]

Third, at a threshold level, the system described in Shirane does not even pertain to a *telematics equipped* mobile vehicle, as it is specifically directed to a fault diagnostic system 2 that interacts with a vehicle ECU 1 via a wired connection (cable 5). In fact, there is no mention of a vehicle *telematics* unit anywhere in Shirane.

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[3] Office Action dated November 17, 2005; page 2
[4] US Patent No. 5,491,631; col. 8, lines 44-46
[5] See Id at col. 10, lines 3-8

New Claims –

New claims 20-26 call for a method of providing vehicle diagnostic function that includes, among other steps: determining a primary diagnostic script for a telematics equipped mobile vehicle wherein the primary diagnostic script includes *a plurality of diagnostics scripts that is determined based on diagnostics options*. At least for the reason that none of the cited references disclose a primary diagnostic script including a plurality of diagnostic scripts, as claimed, it is the Applicant's opinion that newly added claims 20-26 recite patentable subject matter.

Conclusion –

Therefore, in view of the foregoing, the Applicant respectfully submits that all of the pending claims are allowable over the prior art and requests that they be allowed. The Examiner is invited to telephone the undersigned if doing so would advance prosecution of this case.

The Commissioner is hereby authorized to charge Deposit Account No. 07-0960 for any required fees, or to credit that same deposit account with any overpayment associated with this communication.

Respectfully submitted,

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